

## REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

By the above amendments, the instant specification at page 5 has been amended to incorporate the subject matter of originally presented claim 17. Claims 30, 43, 44 and 46-52 have been canceled without prejudice or disclaimer. Claims 29, 31-40 and 42 have been amended for readability and/or clarification purposes. Claim 29 has been amended to recite that the system water temperature at a wellhead is in the range of 80-200°C and a seabed temperature is below 40°C, and the formation of scale in the water system is inhibited at both the wellhead and seabed temperatures. Support for such amendments can be found in the instant specification at least at page 2, lines 21-24, taken in connection with page 14, lines 15-18 (originally presented claim 17).<sup>1</sup> Newly added dependent claim 53 is directed to subject matter deleted from claim 42.

In the Official Action, claims 29-52 stand rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth at page 2 of the Official Action. Withdrawal of this rejection is respectfully requested for at least the following reasons.

The rejection of claim 29 for reciting the terms "high", "low" and "e.g.", and of claim 42 for reciting the term "optionally", is moot in view of the deletion of such terms. The rejection of claims 30, 43, 44, 46, 51 and 52 is moot in view of the above

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<sup>1</sup> As noted above, the instant specification at page 5 has been amended to incorporate the subject matter of originally presented claim 17.

cancellation of such claims. Accordingly, for at least the above reasons, withdrawal of the §112, second paragraph, rejection is respectfully requested.

Claims 29-52 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,071,434 (*Davis et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Independent claim 29 is directed to a process to inhibit the formation of scale in a water system at both wellhead and seabed temperatures comprising a step of adding to the water system a scale inhibiting amount of a composition comprising: (a) a copolymer of an unsaturated phosphonic acid or a salt of such an acid with an unsaturated sulphonic acid or a salt of such an acid or an unsaturated carboxylic acid or a salt of such an acid; or (b) a terpolymer of an unsaturated phosphonic acid or a salt of such an acid with an unsaturated sulphonic acid or a salt of such an acid and an unsaturated carboxylic acid or a salt of such an acid, wherein the system water temperature at a wellhead is in the range of 80-200°C and a seabed temperature is below 40°C, and wherein the formation of scale in the water system is inhibited at both the wellhead and seabed temperatures.

*Davis et al* relates to derivatives of hypophosphorus acid which are of value as, or in the preparation of, polymeric compounds with scale and corrosion inhibiting properties and which are of particular value in the treatment of water in oil field operations, or in anticorrosive pigments. See col. 1, lines 3-8.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For an anticipation to exist, "[t]he identical

invention must be shown in as complete detail as is contained in the . . . claim."

*Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In the present case, *Davis et al* does not disclose each feature recited in independent claim 29, and as such fails to constitute an anticipation of such claim. For example, *Davis et al* does not disclose a process wherein the system water temperature at a wellhead is in the range of 80-200°C and a seabed temperature is below 40°C, and wherein the formation of scale in the water system is inhibited at both the wellhead and seabed temperatures. As noted at page 1, lines 10-11 of Applicants' disclosure, conventional scale inhibitors tend to function well either at high or low temperatures, but not both. *Davis et al* generally discloses that its telomers are more thermally stable than copolymers containing equivalent amounts of phosphorus present entirely in comonomers. See col. 1, lines 54-59. However, *Davis et al* has no disclosure that the formation of scale in the water system is inhibited **at both the wellhead and seabed temperatures**, as is presently claimed. In fact, *Davis et al* does not even mention the use of its compositions at both the wellhead and seabed, let alone disclose that its compositions are employed to inhibit the formation of scale at both wellhead and seabed temperatures.

For at least the above reasons, it is apparent that *Davis et al* fails to constitute an anticipation of independent claim 29. Accordingly, withdrawal of the above rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

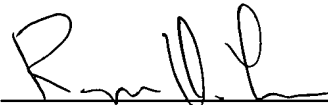
If there are any questions concerning this paper or the application in general,  
the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: January 6, 2009

By:

A handwritten signature in black ink, appearing to read "R. H. Lee", written over a horizontal line.

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